

DOCKET NO: 273621US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :  
JUERGEN SCHMIDT-THUEMMES, ET : EXAMINER: BERNSHTEYN, M.  
AL.  
SERIAL NO: 10/541,206 :  
FILED: JULY 5, 2005 : GROUP ART UNIT: 1796  
FOR: METHOD FOR PRODUCING :  
STABLE AQUEOUS POLYMER  
DISPERSIONS BASED ON  
CONJUGATED ALIPHATIC DIENES  
AND VINYL AROMATIC COMPOUNDS

REPLY BRIEF UNDER 37 C.F.R. § 41.41

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the Examiner's Answer of August 5, 2009, Appellants submit the present Reply Brief and accompanying Remarks in rebuttal.

VII. ARGUMENTS

The Examiner responded to Appellants' May 13, 2009 Appeal Brief on pages 8-11 of the Examiner's Answer. Appellants respond as follows.

Appellants' Examples are Probative of Patentability

The Examiner fails to understand the probative value of the examples disclosed in Appellants' specification (see page 9, first full paragraph of the Examiner's Answer). Appellants' argument "A-1" on pages 5-7 of the May 13, Appeal Brief points out that the claimed invention is significantly superior in comparison to the closest prior art.

In making such a comparison Appellants may provide an example that is closer than the closest prior art (*In re Holladay*, 584 F.2d 384, 199 USPQ 516 (CCPA 1978)). In the examples of the present specification, Appellants compare the process of the invention with a process differing only in that partial neutralization of the monomer mixture “takes place before the polymerization”. No closer comparison is possible.

Any difference between the inventive and comparative example of the present specification is due only to the difference in which the neutralization of the monomer c) is carried out. Appellants have thereby isolated the effect of the afore-quoted feature of the present claims, no closer comparison is possible.

Appellants’ Examples Prove that the Claimed Invention Provides Lower Coagulum in Comparison to the Closest Prior Art

With regard to Appellants’ showing that the claimed invention is able to reduce the amount of coagulum formed during the polymerization, the Examiner appears to take the position that the reduction in coagulum formation is not unexpected and/or is not noteworthy. The Examiner appears to take the position that because some coagulate is present in the inventive examples, no reduction of coagulum in comparison to the comparative example is probative of patentability (see page 9, lines 7-10 of the Examiner’s Answer).

For example, the Examiner takes the position that no reduction in the amount of coagulum is probative of patentability because the cited art discloses examples which “practically do not contain any coagulum.” The Examiner’s position lacks any evidentiary or common sense basis. First of all, the “coagulate” formed in the cited art (i.e., Ostrowicki) is formed in substantially greater quantities than the coagulum formed in the inventive example of the specification. In fact, the minimum amount of coagulate in the examples of the cited art is 0.1%, i.e., 1,000 ppm. This compares with an amount of 105 ppm of “coagulum”

formed in the inventive example of the present specification. If one accepts the Examiner's implicit assertion that coagulum and coagulate are the same, it is inconceivable how the Examiner can take the position that a nearly 90% reduction in the formation of coagulate/coagulum is not probative of patentability.

Further still, there is no evidence of record to show that one of ordinary skill in the art would have foreseen that such a substantial reduction in the amount of coagulum is achievable merely by changing the order of the neutralization, i.e., carrying out neutralization before polymerization.

#### The Cited Art is Contradictory to the Examiner's Basis for Supporting the Rejection

On pages 7-8 of Appellants' May 13, Appeal Brief, Appellants pointed out that Ostrowicki does not suggest changing the order of neutralization in order to reduce the formation of coagulum during polymerization. In the paragraph bridging pages 10 and 11 of the Examiner's Answer, the Examiner now cites to column 4, lines 36-44 of Ostrowicki in support of the rejection. The Examiner appears to be of the belief that this disclosure in some way suggests the presently claimed invention.

The explicit disclosure of the Ostrowicki patent contradicts the Examiner's position. The cited disclosure relates the "rate of metering the emulsifiers during the emulsion polymerization" to the particle size of the thus-produced polymer particles. This has nothing whatsoever to do with the requirement of the present claims that certain monomers are at least partially neutralized prior to polymerization.

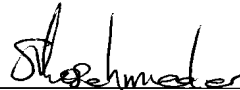
In a desperate bid to support the rejection the Examiner cites to disclosure in Ostrowicki that relates to "coagulate" but fails to provide any reason why this disclosure is in any way suggestive of the presently claimed invention. The Examiner misses the mark by failing to take into consideration that the cited disclosure relates to an aspect of the

Ostrowicki process that is not at issue in the case at bar (i.e., the Examiner fails to connect in any meaningful way the “rate of metering the emulsifiers” to the order of neutralization recited in the present claims).

As argued in Appellants Appeal Brief of May 13, 2009, the Examiner’s rejections of the claims are not sustainable and should be overturned.

Respectfully submitted,

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MAIER & NEUSTADT, L.L.P.  
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